

REMARKS

The Rejection Under 35 USC 103(a) Over Paquette

Claims 1-7, 9-10, 14-15, 17-18, 20-22, 24, 26-27, and 33 were rejected over Paquette under 35 U.S.C. 103(a). Referring to claims 1-2, 14-15, 20, 24, and 33, after discussing the structure of Paquette, the Examiner has stated:

"Whether attachment bar 30 (weight member) is supported by a single, central support member (T-shaped) . . . or having other supporting means such as a pair of legs (32, 34) at its ends (U-shaped) appears to be an obvious matter of design choice to one having ordinary skill in the art, just as long as the single support member or a plurality of supporting members provide adequate support to the weight member to ensure a balanced putter (Col. 1, lines 38-45) which is more forgiving if the ball is not struck precisely at the 'sweet spot' (Col. 1, lines 38-45)".

Claims 1-7, 9 and 10 have not been changed and applicant's position is essentially as previously stated with respect to Paquette, which is that Paquette is not structurally the same, or equivalent or with obvious changes and does not function in the same way as does applicant's structure.

Paquette does not meet any of the following underlined elements of claim 1:

Claim 1 (previously presented)

A golf putter with a clubhead comprising a body having an upstanding striking face and a generally horizontal soleplate:

the improvement thereon comprising
a support extending perpendicularly with respect to
the center of the striking face from the back side of said
striking face and
an elongated weight member secured to said support
and centered thereon,
said weight member being supported substantially
above the level of said soleplate,
and extending generally laterally with respect to said
striking face and
being unsupported at its ends.

In fact, Paquette teaches away from the teaching of the applicant:

The differences in Paquette's putter and that of the applicant, as claimed in claim 1, are as follows:

- 1) The two, not one, legs of Paquette are intentionally spaced away from the "center of the striking face".
- 2) The weight member 28 is not centered on its support "centered thereon" but supported its ends by legs 32 and 34, just the opposite of Finn claim 1.
- 3) The weight 20 of Paquette is not unsupported at its ends - just the opposite - it is only supported at its ends.
- 4) With respect to claim 2, the fundamentally operating element of a claim in the form of the letter U is not the equivalent of a T.
- 5) Regarding claim 9, Paquette having recesses 46 and 48 in legs 32 and 34 behind the face of the blade portion 14 is not the "functional equivalent" of the support for the weight of Finn in claim 9 secured in a bore in the striking face of the blade to enable for the support to actually contact the ball.

6) The principle of Paquette as compared to the applicant is just the opposite. Paquette secures the hosel or shaft 36 to the club head only through a complex structure of block 38, bar 28, legs 32 and 34, which are widely spaced and connected to the blade 14. The U-shape of shaft attachment 36, pin block 38, and weight member 28 of Paquette are thus supported intentionally away from the center of the face, while Finn's shaft is conventionally secured to the blade and his weight is at the center and its ends are unsupported.

7) The weight distribution of claim 17 includes all of the limitations of claim 14 of a weight on a single support centered, unsupported on its ends as in claim 1 and distinguishable from Paquette or any known "official notice" of weight usage in the same manner as claim 1. Weight selection in golf club heads is well known but the weight selection in the applicant's claimed club is important and is meaningful in the combination of claim 17. The other limitations of claim 17 cannot be ignored in evaluating claim 17.

9) Incidentally, regarding weight distribution of claim 17, Paquette teaches to-to-heel distribution of weight in the putter but does not teach, as best can be understood any difference in material between different parts of his putter.

This is a key issue - Is the T-shaped weight bar obvious in the light of Paquette's U-shaped bar? Applicant asserts that it is not obvious and that much is involved in the T-shaped support, which the Examiner has apparently not appreciated. An understanding of the description of Fig. 4 (Page 8, lines 5-12) of the present application

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should make it clear that Paquette's structure cannot function as described. The described "moment arm" is either blocked or minimized in Paquette because any tendency of weight 30 to react as described is effectively blocked by legs 32, 34.

The compensating force of applicant's weight 26 can have no counterpart in Paquette because legs 32, 34 prevent the inertial reaction of his weight 30, as described. Thus, Paquette actually teaches away from applicant's invention, as claimed.

Claim 14 has been amended to add the word --single-- before "support" to point up the fact that applicant teaches and claims "a single support" for his "elongated weight member". This amendment obviously requires no additional search because similar language has been pending in claim 20. This claim is believed clearly allowable over Paquette.

Claims 15, 17, and 18 remain as before other than the above-described change in parent claim 14 and are believed allowable along with claim 14.

Applicant has proposed a change in claim 20 in which a "whereby" provision is added to specifically describe the manner in which applicant's elongated weight member acts to compensate for an off-center hit of a ball. This change is essentially in the language of the description of Fig. 4 of page 8 of applicant's specification, recites no additional structure and is not believed to require any additional search. Claim 20 is believed clearly allowable over Paquette for reasons discussed above.

Claims 21, 22, 24, 26, and 27 are dependent upon claim 20 and remain the same

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as before except for the change in claim 20. These claims are believed to define over Paquette.

Claim 33 is an independent claim and remains the same as before. It distinguishes over Paquette in reciting "an elongated weight member attached at its center to said support with said weight member being evenly balanced on opposite sides of its attachment to said support, said weight member being unsupported at its ends".

Claim 5, which depends from claim 1, recites that the "support is of such length that said weight member is displaced rearwardly from said striking face by an amount greater than the width of said soleplate". It is obvious that Paquette's weight 30 is not displaced rearwardly as described. Weight 30 is clearly within the width of his soleplate. The claim is not met by Paquette and the Examiner's unsupported assertion as to obviousness fails to cure this inadequacy. The obviousness is believed to result only from the teaching of applicant's disclosure. Claim 5 is believed allowable over Paquette for the same reasons as claim 1 and also because it defines structure not taught in Paquette.

Claim 27 is essentially the same as claim 5, namely that the weight member is displaced rearwardly greater than the width of the side plate but dependent upon claim 20 and is believed allowable over Paquette for this reason and for the same reasons set forth above for claim 20.

The Examiner has stated:

"Regarding claims 6, 10, and 21, Paquette discloses the mass distribution increases in the direction going from top surface of the face to the sole and it would be obvious in the claimed invention to mount the balanced weight structure to the top striking face surface for higher center of gravity."

While the Examiner has correctly quoted the teaching on Col. 1, lines 65 and 66 of Paquette, it is also clear that Paquette has concentrated the mass of his putter well toward his soleplate and not "above and to the rear of the top surface of said striking face portion", as claimed in claim 6, which is dependent upon claim 1. Thus, Paquette fails to show the claimed structure of either claim 1 or claim 6, and we are left with assertions as to obviousness based on a reference showing structure quite different from that claimed. Without a clear teaching by Paquette, "obviousness" in reality is the easy misconception arising from hindsight given the applicant's clear teaching.

Claim 10 is also dependent upon claim 1 and recites similar structure.

Claim 21 is dependent upon claim 20 and recites, "said support extends from the top of said rear surface of said striking face portion". This is clearly not the structure of Paquette, so claim 21 clearly fails to read on Paquette. Again, the Examiner appears to be relying upon an assertion as to obviousness in an attempt to stretch the teaching of Paquette far beyond what is fairly taught. It is sincerely believed that claims 6, 10, and 21 are clearly allowable over Paquette.

As to claims 7, 9, 18, and 22, it was stated, "Paquette shows recesses (46, 48) functionally equivalent to the bore to accommodate the legs or support member." Paquette's specification (Col. 12, lines 59-60) states that the legs 32, 34 are formed with

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respective recesses 46, 48 at their distal-free ends and bar 28 is provided with peg portions 50, 52 attached to bight portion 30, which are pressed into recesses 46, 48 forming an interference fit. Considering that the recesses only receive pegs and are not bores "through the center of the striking face" as claimed, and that they are located way off center of the striking face, it is truly an unacceptable stretch to consider such recesses as "functionally equivalent" to applicant's "bore" extending through the striking surface with the support "secured into the bore and exposed to the striking surfaces" (Claim 22; Claim 18 is similar). Clearly the claimed structure is not present in Paquette.

Claim 9 is dependent upon claim 5 and recites, "said striking face member includes a bore through its center and one end of said support is secured in said bore in a position to contact a golf ball . . ." There is certainly no suggestion of an arrangement in Paquette of any description, figure, or suggestion where any of the weight support parts are in a position to contact a golf ball.

Claim 7 has recitations similar to claim 22 but is dependent upon claim 1. Claims 7, 9, 18, and 22 are believed clearly allowable over Paquette.

With respect to the Examiner's argument regarding claim 20, it is recognized that it is conventional to provide a hosel on a club head. However, claim 20 also recites the structure including "a single support shaft" and "an elongated weight member secured to said support shaft and centered thereon, said weight member extending generally parallel to said striking face portion and unsupported at its ends". This structure is not in Paquette and is believed not obvious in the light of Paquette. As stated above, this

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claim has been amended to further describe the function of applicant's putter.

THE REJECTION UNDER 35 USC 103 OVER BAKER IN VIEW OF PAQUETTE

Claims 1-3, 5, 14-15, 20, 24, and 27 were also rejected under 35 U.S.C. 103 as being unpatentable over Baker (5, 716, 290) in view of Paquette '069. The Examiner has conceded that Baker does not show "the weight member is mounted above the soleplate", and yet argues:

"Paquette '069 teaches the attachment bar 30 (weight member) is attached directly behind the striking face with mass distribution increasing from top surface of the face to the sole. Thus it would have been obvious in view of Paquette to one having ordinary skill in the art to provide a support and weight member above the level of the sole plate to achieve a higher center of gravity."

In view of the above statements and the large numbers of patents covering different designs of golf clubs, it would be most remarkable for one to pick out Baker and Paquette and combine them as suggested to obtain the applicant's combination and results. What does one having these references in hand want to do? As stated in the earlier amendatory paper, Baker gives almost no description of the unnumbered portion behind port 112 for receiving the club shaft end. There is not even a numerical designation of this weight. Apparently, the weight is to be balanced on opposite sides of the "X" axis. Since he states, "geometrical symmetry does not attend its body portions which are located on opposite Y-axis sides of recess 112, he is effectively stating that the shape of the weight behind the recess 112 is not significant and could well be

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asymmetrical. This clearly teaches away from applicant's invention.

The Examiner suggests that the man of ordinary skill would want to raise the weight of Baker to get a higher center of gravity. Why? What would cause him to want to do this? There seems to be no reason for the artisan to combine the references as suggested by the Examiner or for the artisan to know what features of Paquette to incorporate in a redesigned putter based on Baker. Nothing in the combination of references would suggest a putter made according to the applicant's design.

It appears that claims 34 and 35 were not specifically acted upon in this last Office Action. Claim 35 has been cancelled herein. Claim 34 is dependent upon claim 33 and is believed allowable for the reasons set forth above regarding claim 33.

Since the Examiner appears to consider applicant's putter design to be like others and that the weight and support arrangement is only a matter of modifying the support to move the weight around, it is believed useful to provide details supporting the long-felt need and commercial success of Mr. Finn's putter.

Enclosed as Exhibit A is a binder containing copies of advertisements and testimonials of prominent professional golfers and others having had occasion to deal with the applicant's T-bar putter along with a Declaration of Mr. Finn attesting to the validity of each entry and document in the binder.

Exhibits s, t, u, and paragraphs 6 and 7 of my Declaration relate to the most prominent of applicant's prior military inventions and are submitted to support the fact that he is not a golf insider and for that matter not a golfer, but he does know how to


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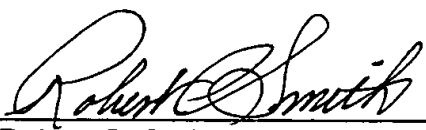
make mechanical inventions that work and are novel often through their fundamental design correctness.

It is believed that upon consideration of the foregoing, the Declaration and Exhibit A, it will be recognized that applicant has shown satisfaction of a long-felt need and commercial success and that the remaining claims are clearly allowable over the cited references.

It is believed that the claims are now in condition for allowance and favorable action is requested. Alternatively, it is requested that this amendment be entered under the provisions of 37 C.F.R. 1.116 as placing the application in better form for appeal.

Respectfully submitted,


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